



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,197	02/14/2001	James McSherry	W0008/7000	6059
21127	7590	12/21/2005	EXAMINER	
KUDIRKA & JOBSE, LLP ONE STATE STREET SUITE 800 BOSTON, MA 02109			JARRETT, SCOTT L	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,197

Applicant(s)

MCSHERRY, JAMES

Examiner

Scott L. Jarrett

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-19, 22-35, 38, 40-45 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-19, 22-35, 38, 40-45 and 48-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This non-final office action is responsive to Applicant's Request for Continued Examination filed October 31, 2005. Applicants amendments filed October 31, 2005 and August 5, 2005 amended claims pending claims 1-3, 6-19, 22-35, 38, 40-45, canceled claims 4-5, 20-21, 36-37, 39 and 46-47 and added new claims 48-52. Currently claims 1-3, 6-19, 22-35, 38, 40-45 and 48-52 are pending.

Response to Arguments

2. Applicant's arguments with respect to pending claims 1-3, 6-19, 22-35, 38, 40-45 and 48-52 have been considered but are moot in view of the new ground(s) of rejection.

3. It is noted that the applicant did not challenge the Official Notices in the previous office actions therefore those statements as presented are herein after prior art. This admitted prior art includes at least:

- the utilization of Customer Relationship Management (CRM) systems by companies to better serve their customers by offering personalized (tailored) products/services based on a plurality of customer information (customer preferences, buying habits, demographics, specialist performance, service requests, complaints, product returns, etc.) collected, stored, analyzed and reported on by the system;
- the ability of CRM systems to retrieve and store information relevant to the customer, in response to a customer contact/call;
- the querying a database to generate one or more reports;

- the collecting (capturing) of a plurality of user information, by call/contact centers, related to each contact made wherein the contact is categorized for each user contact (e.g. call type) and enables the organization to better understand the nature of the contacts being made; and

- the utilization of content management systems to power content rich and/or dynamic web sites wherein these content management systems are commonly architected and implemented using templates (look & feel) and databases (content) in order to provide for the efficient management, presentation and personalization of dynamic web site content.

Claim Objections

4. Claims 1, 17, 27, 33 and 48 are objected to because of the following informalities. Appropriate correction is required.

Regarding Claims 1, 17, 33 and 48 the system/method for managing workplace services as claimed merely connects users and specialist "in order that the specialist *can* provide assistance" however the system/method as claimed does not actually provide assistance by the specialist/expert. For the purposes of examination examiner assumes the applicant will amend the claims to recite that system/method for managing workplace services actually provides specialist/expert assistance to users.

Art Unit: 3623

Regarding Claim 27 the system and method for managing workplace services merely connects the specialist to the system so the specialist “*can* obtain user identifying information” however the system/method does not actually obtain the user information as claimed. For the purposes of examination examiner assumes the applicant will amend the claim to recite that system/method for managing workplace services actually obtains user identifying information.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6-19, 22-35, 38, 40-45 and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst & Young's Online Business Consulting system and method (Ernie) aspects of which are disclosed in at least the following references:

- I. Litwin, Eric, The Evolution of Ernie – The Online Business Consultant (Jan. 1998), herein after reference A.;
- II. Baum, Brian, Ernie – four years of online consulting (May 2000), herein after reference B; and
- III. Weiss, Jiri, Firms Package Knowledge to Go (Dec. 2000), herein after reference C.

Regarding Claims 1, 17 and 33 Ernie teaches an Internet-based system and method for providing customized professional/consulting services (advice, information, etc.) to organizations (clients, users, businesses, subscribers, firms, people, contacts, etc.) launched in 1996 wherein "Once subscribers log on through our web page, they can ask Ernie a specific question (see Figure 1), or they can search our database of previously asked questions to see how our consultants have answered the same or related questions for other subscribers. If they opt for the first, they are instructed to

Art Unit: 3623

categorize the question by type – accounting, human resources, tax, information technology and so forth – specify the problem and provide some background information. Once the question is submitted, it is fielded by one or our small team of frontline “focal knowledge providers” (FKPs). An FKP is a staff person who is highly conversant in Ernst & Young professional practices and individuals with specialized knowledge. The FKP reviews the question and routes it via our intranet to the E&Y professional most qualified to respond. The professional answers the subscriber’s question within two business days via the Internet. In some cases, the consultant will ask the subscriber via the Internet to clarify his or her question or to submit additional background information” (reference B: Paragraph 4, Page 2; reference A: Page 3).

More specifically Ernie teaches an Internet-based system and method for managing workplace services provided by specialists (consultants) to a plurality of users who are members of an organization (firm, business, etc.) comprising:

- upon a request from the organization (i.e. users/businesses/subscribers subscribing to the Ernie system) making a plurality of customized/specific/tailored workplace services/information available (reference A: Pages 8 and 12-13; reference B: Paragraphs 1-4, Page 2; Paragraphs 2-3, Page 3);

- using workplace resource office personnel (focal knowledge providers, FPKs, internal clearing house, call center, etc.) who are familiar with workplace services but not specialist to create, review and route workplace service questions/issues/requests containing issue as well as user and/or organization background information (reference A: Column 1, Paragraph 2, Page 8; Column 1, Page 12; reference B: Paragraphs 1-4,

Art Unit: 3623

Page 2; "Ernie staffers even help them over the phone to formulate their initial questions.", Paragraph 4, Page 4);

- creating a database containing user and organization background as well as user identification information (reference A: Column 2, Paragraphs 1-2, Page 6; Column 2, Last Paragraph, Page 8; Page 20; reference B: Paragraph 4, Page 2; Paragraph 2, Page 3);

- connecting the workplace resources office ("FKP staffer", frontline team, business, group, team, personnel, staff, etc.) to the system (network and database) in order to store user and organization information in the system/database (reference A: Column 1, Page 14; Pages 20, 24; reference B: Paragraphs 2-4, Page 2; Paragraph 3, Page 4);

- establishing a communication session (e.g. email request for assistance) between one of the plurality of users and a specialist (consultant) who is not one of the workplace resources office personnel (focal knowledge providers) who provides advice/information on a specific workplace issues to that user wherein during each communication session the specialist receives user identifying information and retrieves the user's/organization's background information from the system and uses the information to provide specific live assistance to the user concerning the specific workplace issue (reference A: "Dialogue with Ernie"; Column 1, Paragraph 1, Page 6; Column 1, Page 14; reference B: Paragraphs 2-4, Page 2; Paragraphs 2-3, Page 3; Paragraph 3, Page 4); and

Art Unit: 3623

- storing information concerning each communication session and adding the communication session information to the user's/organization's background information (reference A: Column 1, Paragraph 2, Page 9; Pages 20 and 24; Column 3, Paragraphs 3-4; Page 13; reference B: Paragraphs 2-5, Page 3).

While Ernie teaches providing specific advice/consultation regarding specific work place issues based on user/organization and issue background information collected/provided prior to the dispensing/providing of the workplace services/advice Ernie does not expressly teach using workplace resource office personnel to contact the plurality of users and obtain user and organization background information as claimed however these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless who, what entity, collects and/or provides the user/organization, issue or background information upon which the workplace services/advice are provided. Further, the structural elements remain the same regardless of who, what entity, collects and/or provides the user/organization, issue or background information upon which the workplace services/advice are provided. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Regarding Claims 2, 18 and 34 Ernie teaches a system and method for managing and providing of workplace services wherein the communication session is a telephone call (reference A: Column 2, Paragraph 2, Page 3; reference B: Paragraphs 2 and 4, Page 2; Paragraph 3, Page 4).

Regarding Claims 3, 19 and 35 Ernie teaches a system and method for managing and providing of workplace services wherein the communication session is an email message (reference A: Column 1, Paragraph 1, Page 14; reference B: Paragraphs 2-4, Page 2).

Regarding Claims 6, 22 and 38 Ernie teaches a system and method for managing and providing of workplace services wherein the network is the Internet (reference A: Pages 21-22; reference B: Paragraphs 2-4, Page 2).

Regarding Claims 7 and 23 Ernie teaches a system and method for managing and providing of workplace services wherein the user identifying information is a unique personal ID code (e.g. login name/password; reference A: Column 3, Paragraphs 3-4, Page 13; Paragraphs 2-4, Page 23; reference B: Paragraph 4, Page 2).

Regarding Claims 8, 10, 24 and 26 Ernie teaches a system and method for managing and providing of workplace services wherein the user identifying information is a unique personal ID code as discussed above.

Ernie does is silent on who, what entity/entities (i.e. the personal ID code is assigned by the workplace services office or the web site/system), assigns the personal ID code to each of the plurality of users.

Official notice is taken that there exists a plurality of well known and commonly used methods/approaches to assigning unique identifiers to users (organizations, firms, people, contacts, etc.) including but not limited to having a system generate/assign unique identifies, having a person (e.g. system administrator) assign users unique identifiers or having the user assign/select/create their own unique personal identifier.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for managing workplace services as taught by Ernie with its ability to uniquely identify users/organizations would have benefited from utilizing any of a plurality of well known approaches to assigning unique/personal identifiers to users in view of the teachings of official notice; the resultant system providing user/client specific workplace services (e.g. advice; reference A: Pages 12-13).

Further it is noted that while Ernie is silent on who, what entity, assigns (creates, generates, etc.) the unique personal identifier as claimed; these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps

Art Unit: 3623

would be performed the same regardless who, what entity, assigns the unique personal identifier. Further, the structural elements remain the same regardless of who, what entity, assigns the unique personal identifier. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106.

Regarding Claims 9 and 25 Ernie teaches a system and method for managing and providing of workplace services further comprising:

- establishing a web site connected to the system/database by the Internet (reference A: Column 3, Paragraphs 3-4; Pages 13, 25; Page 12; reference B: Paragraph 4, Page 2); and
- using the web site to collect background information from each of the plurality of users (reference A: Column 3, Paragraphs 3-4; Page 13; Pages 12, 20, 24-25; reference B: Paragraph 4, Page 2; Paragraph 3, Page 4).

Regarding Claims 11 and 27 Ernie teaches an system and method for managing and providing of workplace services wherein the specialist (consultant) is connected to the system (database) via the Internet and the specialist obtains user identifying information, enters the user identifying information into the system via the web/Internet and receives users/organization background information via the Internet browser (reference A: Pages 20, 24-25; reference B: Paragraph 3, Page 2).

Ernie does not expressly teach *verbally* receiving from the user their user identification (personal ID, identification information, etc.) as claimed.

Official notice is taken that obtaining user identifying information verbally from users in order to retrieve, provide and/or collect additional information based on the user identification is old and very well known. For example it is common for call centers, such as those used by banks/credit card companies, to request users to identify themselves and then to use the user identification information to “look up” the users account information.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for managing workplace services customized/tailored to specific users/organizations based on their unique identification and background information as taught by Ernie would have benefited from collected/determining the identity of the user by utilizing any of a plurality of well known methods including but not limited to verbally receiving the user’s identification information in view of the teachings of official notice.

Further it is noted that while Ernie does not expressly teach receiving a users identification information *verbally* as claimed; these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited

Art Unit: 3623

nor do they alter the recited structural elements. The recited method steps would be performed the same regardless the manner in which the user identification information is acquired (i.e. either verbally or electronically). Further, the structural elements remain the same regardless of the manner in which the user identification information is acquired (i.e. either verbally or electronically). Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Regarding Claims 12 and 28 Ernie teaches a system and method for managing and providing of workplace services further comprising:

- assigning the communication session information to one of a plurality of predefined categories (reference A: Column 3, Paragraph 2, Page 13; question type; Pages 20 and 24; reference B: Paragraphs 2 and 4-5, Page 3); and
- storing the communication session category information in the system/database (reference A: question type; Pages 20 and 24; reference B: Paragraphs 2 and 4-5, Page 3).

Ernie does not expressly teach that the *specialist* (consultant, expert) assigns the communication session information to one of a plurality of predefined categories as claimed.

Official notice is taken that categorizing calls, as taught by Ernie, is old and well known and further it is well known that a plurality of approaches and mechanisms exist for categorizing the calls into one or more predefined categories such as users "self-categorizing", call taker (e.g. receptionist, FPK, etc.) categorization and call/issue answerer categorization (e.g. technical support categorizing a support call as closed, pending, in-progress or the like) as such call category information enables the organization/specialist to better understand the nature of the contacts being made and/or issues being addressed.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for managing workplace services as taught by Ernie with its ability to categorize workplace service requests would have benefited from enabling a plurality of entities (users, systems, etc.) to categorize the requests into one or more predefined categories in view of the teachings of official notice.

Further it is noted that while Ernie does not expressly teach that the specialist/expert assign communication sessions to a predefined category; these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of who, what entity, assigns the communication session information to one of a plurality of predefined categories. Further, the structural elements remain the same regardless of

Art Unit: 3623

who, what entity, assigns the communication session information to one of a plurality of predefined categories. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106.

Regarding Claims 13 and 29 Ernie teaches an system and method for managing and providing of workplace services further comprising performing a query on the information in the system/database, generating a report from the query and providing the report to the organization (reference A: Column 2, Paragraph 1, Page 9; reference B: Paragraphs 4-5, Page 3; reference C: "on Ernie, a human directs queries to the appropriate E&Y consultant. Once the specific question is answered, editors also strip off its proprietary content and place it in a searchable database of previously asked questions. The questions themselves, which are tracked by industry and job functions, become a source of market intelligence. Online customers can see what questions are being asked by their colleagues by consulting Ernie TrendWatch.", Paragraph 1, Page 2; Paragraphs 2-4, Page 5; reference C: Paragraph 1, Page 2).

Regarding Claims 14 and 30 Ernie teaches a system and method for managing and providing of workplace services wherein the query is performed on category information in the system/database (reference A: Column 1, Paragraph 2, Page 9;

Art Unit: 3623

Column 2, Paragraph 1, Page 9; reference B: Last Paragraph, Page 2; Paragraphs 2 and 4-5, Page 3).

Regarding Claims 15 and 31 Ernie teaches a system and method for managing workplace services further comprising using workplace resource office (team, organization, personnel, etc.) to generate a templated (dynamic, customized, etc.) web site accessible to the plurality of users via the Internet (reference A: Pages 21-22; reference B: Paragraph 4, Page 2). Ernie further teaches that the web site can be created (managed, developed, deployed, etc.) by a plurality of users/organizations (e.g. E&Y, workplace resource office, created Ernie for its employees and clients as well as provides the system for clients/businesses to create their own workplace service sites; intra-Ernie, Ernie-like platform; reference B: Paragraphs 2-4, Page 5).

Regarding Claims 16 and 32 Ernie teaches a system and method for managing workplace services further comprising publishing workplace issue information, from the system/database, onto the templated web site (frequently asked questions, FAQs, previously asked questions, PAQs, issues database, etc.; reference A: Pages 12 and 21-22; Column 3, Paragraphs 3-4, Page 13; reference B: Paragraph 4, Page 2; Paragraphs 2-4, Page 5; reference C: Paragraph 1, Page 2).

Regarding Claims 40, 42 and 44 Ernie teaches a system and method for managing workplace services wherein the workplace resource office (personnel, staff,

physical location, room, etc.) is not part of (an employee, employed by, physically part of, associated/affiliated with, connected, etc.) the organization (reference A: Column 1, Page 8; Pages 12-13; reference B: Paragraph 2-4, Page 2).

Regarding Claims 41, 43 and 45 Ernie teaches a system and method for managing workplace services wherein the specialist (consultant) is not part of the organization (reference A: Pages 8 and 12-13; reference B: Paragraph 2-4, Page 2).

Regarding Claim 48 Ernie teach a method for managing legal advice (e.g. tax, immigration advice) and counseling providing by legal experts (specialists, consultants, etc.) to a plurality of people (contacts, clients, users) who are members of an organization by means of a computer system connected to the Internet comprising:

- upon a request from the organization (i.e. users/businesses/subscribers subscribing to the Ernie system) making a plurality of customized/specific/tailored workplace services/information available based on a plurality of collected background and other information (reference A: Pages 11-12; reference B: Paragraphs 1-4, Page 2; Paragraphs 2-3, Page 3);
- using workplace resource office personnel (focal knowledge providers, FPKs, etc.) who are familiar with legal advice but not specialist to create, review and route questions/issues/requests containing issue as well as user and/or organization background information (reference A: Columns 1-2, Page 12; reference B: Paragraphs

Art Unit: 3623

1-4, Page 2; "Ernie staffers even help them over the phone to formulate their initial questions.", Paragraph 4, Page 4);

- creating a database (centralized) containing user and organization background as well as user identification information (reference A: Pages 20-22; reference B: Paragraph 4, Page 2; Paragraph 2, Page 3);

- connecting the workplace resources office (call center, receptionist, FKP's, etc.) to the system/database via the Internet and storing background information for the plurality of users/people collected prior to the users/persons contacting a legal expert (specialist, consultant, counselor, etc.; reference A: Columns 1-2, Page 12; reference B: Paragraphs 2-4, Page 2; Paragraph 3, Page 4);

- establishing a communication session between one of the plurality of users/people and a legal expert who is not one of the workplace resources office personnel, providing advice on a specific legal issue to the user wherein during the communication session the expert receives user identifying information, retrieves the user's/organization's background information from the system and uses the information to provide specific live assistance to the user concerning the specific workplace issue/legal question (reference A: Pages 12-13 and 20; reference B: Paragraphs 2-4, Page 2; Paragraphs 2-3, Page 3; Paragraph 3, Page 4); and

- storing in the system/database information concerning the communication session and adding the communication session information to the user's/organization's background information (reference A: Pages 8, 12-13 and 20; reference B: Paragraphs 2-5, Page 3).

While Ernie teaches providing specific advice/consultation regarding specific work place issues based on user/organization and issue background information collected/provided prior to the dispensing/providing of the workplace services/advice Ernie does not expressly teach using workplace resource office personnel to contact the plurality of users and obtain user and organization background information as claimed however these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless who, what entity, collects and/or provides the user/organization, issue or background information upon which the workplace services/advice are provided. Further, the structural elements remain the same regardless of who, what entity, collects and/or provides the user/organization, issue or background information upon which the workplace services/advice are provided. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Regarding Claim 49 Ernie teaches a system and method for managing legal advice that is applicable to a plurality of industries, businesses/organizations and/or users including but not limited to tax, human resources, management, accounting, information technology, finance and the like (reference A: Page 11; reference B: Paragraph 4, Page 2).

Ernie does not expressly teach that an insurer contracts with the workplace resources office and the organization is insured by the insurer as claimed; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the intended field of use of the system/method and/or the nature of the legal advice being managed. Further, the structural elements remain the same regardless of the intended field of use of the system/method and/or the nature of the legal advice being managed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Regarding Claim 50 Ernie teaches a system and method for managing legal advice wherein the legal experts (specialists) are associated (part, linked, affiliated, employed, etc.) with the workplace resources office (reference A: Page 11; reference B: Paragraph 2-4, Page 2).

Regarding Claim 51 Ernie teaches a system and method for managing legal advice wherein the users/people are employees of the organization (reference A: Pages 8, 12-13; reference B: Paragraph 2-4, Page 2).

Regarding Claim 52 Ernie teaches a system and method for managing legal advice further comprising:

- performing a query on the information in the system/database (reference A: Page 9; reference B: Paragraphs 1-2 and 4-5, Page 3);
- generating a report from the query (TrendWatch, Insite, MediaWatch, etc.; reference A: Page 9; reference B: Paragraphs 1-2 and 4-5, Page 3; reference C: Paragraph 1, Page 2); and
- generating a templated (dynamic) web site based on the report that is accessible to users/people via the Internet (i.e. publishing PAQs, articles or other information related to "hot topics" or getting more consultants involved in areas having a large number of questions being asked (reference A: Pages 21-22 and 25; reference B: Last Paragraph, Page 2; Paragraphs 1-3, Page 3; reference C: Paragraph 1, Page 2).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Metzler et al., U.S. Patent No. 6,366,925, teach a system and method for managing legal advice and counseling provided by legal experts to a plurality of contact people (clients) by means of a computer system connected to the Internet. Meltzer et al. further teach collecting, via the Internet, a plurality of user/organization information related ("interrogative interface") that is stored in a centralized database and utilized to provide specific legal advice and that the system enables users/clients to "post inquiries to the legal services provider" via a query interface ("E-consultation") as well as view frequently asked questions.

- Lee et al., U.S. Patent No. 6,839,707, teach a method and system for managing legal advice and counseling provided by legal experts to a plurality of contact people/clients by means of a computer system connected to the Internet.

- Heston, Robert L., U.S. Patent Publication No. 2002/0019741, teaches a system and method for managing legal advice and counseling provided by legal experts to a plurality of contact people by means of a computer connected to the Internet wherein the system/method, via a templated web site connected to a database, enables "the client interacts with the system by providing various information or searching for topics related to areas of interest to the client" thereby enabling the automation of well known/routine legal services such as "initial questions being asked by clients, reviewing or receiving information sought by clients on consumer or other areas of law, viewing

Art Unit: 3623

actual or sample legal documents such as letters, leases, agreements, and all types of documents that clients may wish to view.”

- Cortada, James et al., The Knowledge Management Yearbook 1999-2000 (1999) teach a plurality of old and well known knowledge management systems, methods and approaches including but not limited to the common approaches/methods for collecting, categorizing and disseminating workplace services/knowledge (interviews, questionnaires, etc.). Cortada et al. further teach the well-known use of knowledge management systems/methods by consulting firms for a plurality of industries/practices including but not limited to insurance.

- Skyrme, David, Capitalizing on Knowledge (2001) teaches a plurality of well known knowledge management systems, methods and approaches including but not limited to “productizing knowledge” wherein businesses/organizations provide workplace and other services (information, products, etc) by capturing and sharing knowledge (e.g. experts for sale, consultancy, contracting, knowledge services, etc.).

- Price Waterhouse LLP Introduces KnowledgeView (1995) teaches an online system and method for providing workplace services wherein consultants (experts) provide tailored and specific advice to a plurality of users/organizations/clients.

- Ernie and K-Man are Here to Answer your Questions (1996) teaches the availability and public use of two systems and methods for managing workplace services (K-Man by KPMG Peat Marwick, Ernie by Ernst & Young).

- Accounting firms make a big hit on the Net (1996) teaches the commercial availability and public use of E&Y’s Ernie workplace services system and method

Art Unit: 3623

wherein "clients can email specific questions, which will be routed to the best person in the firm to answer them" (i.e. using the Internet to disseminate paid-for consulting advice).

- Tom, Field, Help Yourself (1997) teaches a plurality of workplace services systems and methods wherein users (contacts, people, organizations) can access the Internet-based systems to get specific advice and/or access to specific/individualized information and services. More specifically Field teaches the public sale "Ernie", launched in 1996, wherein Ernie provides a database of common workplace issues (problems, previous asked questions) as well as live/specific advice from E&Y consultants. Field also teaches that E&Y initially considered offering the Ernie system/method via a dedicated call center but decided to use the Internet instead.

- Arthur Anderson to launch web-based service for business executives – Knowledgespace (1997) teaches a system and method for managing workplace services wherein the system/method gives "subscribers customized access to a bank of knowledge, helping them to develop fresh ideas, save time, save money and learn." The article further teaches that unlike E&Y's Ernie system/method Knowledgespace is not "an online connection to firm professionals."

- Kaufman, Steve, Online Consulting Aids Small Business (1998) teaches the public use and/or sale of a workplace services system and method wherein users/organizations are provided specific/live advice to workplace issues by a wide-range of consultants (experts, specialist) including but not limited to health insurance, tax, immigration issues or the like. Kaufman further teaches that several consulting

Art Unit: 3623

firms offer “online consulting” system and methods and that such systems/methods “mostly bring the advice of a live consultant, but the stage has already been set for more automated offerings.”

More specifically Kaufman teaches that “subscribers give Ernie their questions, Ernie “knowledge providers” sort the questions by subject, then route them through Ernst & Young’s intranet to the appropriate personnel”, and that “Online consulting is more likely to provide solutions to problems because it’s usually responding to a specific action-oriented question.” Kaufman further teaches that the online consulting systems/methods include access to a searchable database of previously asked questions and provides systems/methods for monitoring and reporting on trends (TrendWatch, MediaWatch).

- Callahan, Maureen, JobOptions and HeathWindows Form New Partnership (1998) teaches a workplace services system and method for providing “information and services expressly tailored to the needs and interests of their members, customers or employees.”

- Tiwana, Amrit, The Knowledge Management Toolkit (1999) teaches a plurality of well known methods, techniques and systems/tools for managing knowledge management systems/methods.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (571) 272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SJ
12/19/2005


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600